

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ellen E. Drew, et al.

Application No.: 10/616,738

Confirmation No.: 2764

Filed: July 9, 2003

Art Unit: 3689

For: SYSTEM AND METHOD FOR MATCHING
USER IDENTIFIED ENVIRONMENTAL
PROJECTS WITH RESOURCE PROVIDERS

Examiner: Heidi M. Riviere

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre Appeal Brief Request for Review

Dear Examiner:

This Request is being filed in connection with a Notice of Appeal.

Status

Claims 1, 17-20, 23-25, 27-31, and 37-46 are rejected under 35 U.S.C. §102(b) as being anticipated by Spencer (U.S. Pat. No. 6,356,909) ("Spencer") and claims 1-2, 4-20, and 22-46 are rejected under 35 U.S.C. §103(a) as being unpatentable over Spencer in view of Vanderboom ("Vanderboom"). Claims 1, 2, 4-20, and 22-46 remain pending and are examined on the merits.

I. Claims 1, 17-20, 23-25, 27-31, and 37-46 are NOT Anticipated by Spencer

In the Office Action dated July 25, 2008, claims 1, 17-20, 23-25, 27-31, and 37-46 stand rejected under 35 U.S.C. §102(a).

A. Independent Claims 1, 37, 40, 42, 44, and 45

Respectfully, the Applicants disagree with the Examiner's rejection. For a *prima facie* case of anticipation to be established, the Examiner must show that, each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131

Spencer teaches a web based computer system for managing creation of a RFP and responding to the RFP. The RFP is generated by an initial user(s) (purchasers) by accessing and selecting questions stored on a questions database to produce a created RFP. The created RFP is then stored on a website accessible by a RFP respondent(s) (vendors) after being notified by electronic means, such as by email. The vendor accesses a response database, which responses are stored thereon, that is linked to the questions database, which is accessible through the website. Responses are selected by the respondent to create a proposal that is stored on the website. The user is then notified that the proposal is stored for their viewing.

Spencer does not teach displaying a user with an environmental project survey that includes a plurality of criteria data categories. Further, Spencer does not teach that the environmental project survey has hierarchically organized tiers of criteria data categories, such that when they are selected by a user, they display subcategories relating to the criteria data categories. It further does not teach that the subcategories are selected from at least one of air, energy, land, waste, and water. Hierarchically organized tiers are structural components that are not found in Spencer. Nor does it teach that once a criteria data category has been selected by the user, a subcategory relating to the selected criteria data category is then displayed to the user for further selecting. Additionally, Spencer does not teach selecting one of the environmental projects for funding by the at least one resource provider.

Applicants have previously amended claim 1 to clarify that the system displays these hierarchical organized tiers of criteria data categories in this manner and then further displays subcategories relating to the selected criteria data categories. Also, claim 1 was previously amended to clarify that an environmental project is selected form funding by at least one resource provider. In light of the limitations presented and structure relating to the hierarchical nature of the display and the relatedness of the specifically claimed criteria data categories, the Examiner is respectfully requested to reconsider the conclusion that such limitations are nonfunctional descriptive material. Especially, in light of the fact that claim 1 is directed to specifically environmental projects, resource providers, users, and funding of projects to be completed by the selected users of the system. Claims 37 and 40 have also been previously amended to clarify these limitations as discussed relating to claim 1. Claims 44 and 45 include substantially analogous limitation as claims 1, 37, and 40.

Applicants respectfully submit that Spencer does not teach each and every claim element of the Applicants' application as amended herein, and thus does not establish a *prima facie* case of anticipation. Therefore, it is believed that these rejections are overcome and Claims 1, 37, 40, 42, 44, and 45 are allowable under 35 U.S.C. §102(b).

B. Dependent Claims 17-20, 23-25, 27-31, 38, 39, 41, 43, and 46

As stated above, Applicants believe that independent claims 1, 37, 40, 42, 44, and 45 are allowable over the cited art. Dependent claims 17-20, 23-25, 27-31, 38, 39, 41, 43, and 46 each depend from these independent claims, respectively, and add further limitations. Accordingly, Applicants believe claims 17-20, 23-25, 27-31, 38, 39, 41, 43, and 46 should also be allowed under 35 U.S.C. §102(b).

II. Claims 1-2, 4-20, and 22-46 are NOT unpatentable over Spencer in view of Vanderboom

In the Office Action dated July 25, 2008, claims 1-2, 4-20, 22-46 stand rejected under 35 U.S.C. §103(a) as discussed above. For a *prima facie* case of obviousness to be established, the following factual inquiries as enunciated in *Graham* must be determined: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims at issue; (C) determining the level of skill in the pertinent art; and (D) evaluating any evidence of secondary considerations. Further, in *KSR*, a number of rationales for supporting a conclusion of obviousness consistent with the "functional approach" in *Graham* were laid out. Additionally, it is key that the Examiners articulate their reason why the claimed invention would have been obvious. (MPEP 2143)

A. Independent Claims 1, 37, 40, 42, 44, and 45

Respectfully, Applicants disagree with the Examiner's rejection. As discussed above, Spencer does not teach all the limitations as found in claims 1, 37, 40, 42, 44, and 45. Vanderboom teaches an online laboratory services brokerage system that is used to maintain a network and database of member laboratories that have underutilized capabilities. RFPs are submitted for laboratory services and the database of available or underutilized capabilities is searched to match the RFP with a laboratory having available related service capacity.

Vanderboom does not teach displaying a user with an environmental project survey that includes a plurality of criteria data categories, nor does it teach that the environmental project survey

has hierarchically organized tiers of criteria data categories, such that when they are selected by a user, they display subcategories relating to the criteria data categories. It further does not teach that the subcategories are selected from at least one of air, energy, land, waste, and water. Hierarchically organized tiers are structural components that are not found in Vanderboom. It does not teach that once a criteria data category has been selected by the user, a subcategory relating to the selected criteria data category is then displayed to the user for further selecting. Additionally, Vanderboom does not teach selecting one of the environmental projects for funding by the at least one resource provider.

Claim 1 has been previously amended to clarify these limitations as discussed above with respect to Spencer. For the reasons stated above with respect to the Spencer, and further in view of the reasons stated regarding Vanderboom, and further in light of amended independent Claim 1, Applicant respectfully submits that these two references do not form the basis of a *prima facie* case of obviousness of independent claim 1. Independent claims 37, 40, 42, 44, and 45 contain analogous limitations as independent claim 1. Therefore, it is believed that claims 1, 37, 40, 42, 44, and 45 are allowable under 35 U.S.C. §103(a).

B. Dependent Claims 2, 4-20, 22-36, 38, 39, 41, 43, and 46

As stated above, Applicants believe that independent claims 1, 37, 40, 42, 44, and 45 are allowable over the cited art. Dependent claims 2, 4-20, 22-36, 38, 39, 41, 43, and 46 each depend from these independent claims, respectively, and add further limitations. Accordingly, Applicants believe claims 2, 4-20, 22-36, 38, 39, 41, 43, and 46 should also be allowed under 35 U.S.C. §103(a).

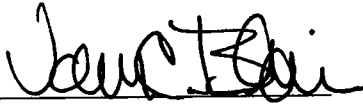
Conclusion

In view of the forgoing, the Panel is respectfully requested to allow claims 1, 2 4-20, and 22-46. This Brief is being filed in conjunction with a Petition for a Three-Month Extension of Time. The Extension fee of \$555.00 and the Notice of Appeal fee of \$270.00 for total fees of \$825.00 to be paid with this filing. Applicant believes no additional fees are due for this filing. If any additional fees are due or any overpayments have been made; however, please charge or credit Deposit

Account No. 50-2816 of Patton Boggs LLP, under Order No. 970767.0201PTUS from which the undersigned is authorized to draw.

Dated: January 26, 2009

Respectfully submitted:

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